

REMARKS/ARGUMENTS

This Amendment is being filed in response to the final Official Action of November 7, 2008, and concurrent with a Request for Continued Examination (RCE). The Official Action rejects all of the pending claims, namely Claims 1-101, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,257,386 to McDonnell et al., in view of U.S. Patent Application Publication No. 2002/0194205 to Brown et al., U.S. Patent Application Publication No. 2002/0026645 to Son et al., and U.S. Patent No. 6,035,104 to Zahariev, alone or further in view of one of U.S. Patent Application Publication No. 2003/0120802 to Kohno, U.S. Patent Application Publication No. 2004/0198426 to Squibbs et al., PCT Patent Application Publication No. WO 2003/026216 to Kobayashi, or U.S. Patent Application Publication No. 2003/0084128 to Anderson. More particularly, the Official Action rejects Claims 1-8, 12, 13, 23-30, 34, 35, 45-48, 51, 52, 58-65, 69, 70, 80-87, 91 and 92 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev. The Official Action rejects Claims 9, 11, 15-20, 31, 33, 37-42, 50, 53-57, 66, 68, 72-77, 88, 90 and 94-99 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Kohno; rejects Claims 10, 32, 49, 67 and 89 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Squibbs; rejects Claims 14, 36, 71 and 93 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Kobayashi; and rejects Claims 21, 22, 43, 44, 78, 79, 100 and 101 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Anderson.

As explained below, however, Applicants respectfully submit that the claimed invention is patentably distinct from McDonnell, Brown, Son, Zahariev, Kohno, Squibbs, Kobayashi and Anderson, taken individually or in any proper combination. Nonetheless, Applicants have amended various ones of the claims to further clarify the claimed invention, including cancelling Claims 59 and 81. In addition, Applicants have cancelled system Claims 1-22, and added new system Claims 102-123. In view of the amendments to the claims and the remarks presented herein, Applicants request reconsideration and allowance of all of the pending claims of the present application.

A. Note regarding Claim Construction

Initially, Applicants note that in the first Official Action, the Office has failed to provide Applicants with a sufficient claim construction or interpretation of the cited references so as to enable the Applicants to effectively reply. *See* MPEP §§ 706, 706.07. In this regard, as has been recognized by the Board of Patent Appeals and Interferences (BPAI), “The Examiner must make specific findings as to claim construction.” *Ex parte* Blankenstein et al., Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see* *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997) (emphasis added). In the instant case, other than quoting or paraphrasing Applicants’ claim language with annotated citations to figures, or column and line numbers of the cited references, the Office provides no finding or other explanation regarding Applicants’ claims, the cited references, or the application of the cited references to Applicants’ claims.

In view of the foregoing, should the Examiner continue to reject the claims as being unpatentable over the same or any other ground, Applicants respectfully request that the Office submit on the record specific findings as to the construction being applied to the claims, an explanation of the references being cited against the claims, and how those references disclose recited features of the claims.

B. Claims 23-30, 34, 35, 45-48, 51, 52, 58-65, 69, 70, 80-87, 91 and 92 are Patentable

The Official Action rejects Claims 1-8, 12, 13, 23-30, 34, 35, 45-48, 51, 52, 58-65, 69, 70, 80-87, 91 and 92 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev. According to one aspect of the claimed invention, as reflected by amended independent Claim 23, an apparatus is provided that includes a processor and a memory storing executable instructions that in response to execution by the processor cause the apparatus to at least perform a number of functions. As recited, the functions include sending an upload request to a recipient, where the upload request comprising a request to upload content from the apparatus to the recipient; receiving, from the recipient in response to the upload request, an upload schedule relating to at least one of the time or manner of uploading the content; and uploading the content to the recipient in accordance with the upload schedule.

I. Requesting Upload / Receiving Upload Schedule

In contrast to amended independent Claim 23, none of McDonnell, Brown, Son or Zahariev, taken individually or in any proper combination, teach or suggest sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload. The Official Action continues to allege that McDonnell discloses a sender requesting to upload content to a network entity, but concede that McDonnell does not teach or suggest receiving, from the network entity, a schedule for that upload. For this feature, the Official Action continues to cite Brown, and alleges that one skilled in the art would have been motivated to modify McDonnell per Brown “in order to efficiently upload content due to bandwidth, time, file size, and various criteria.” Official Action of Jun. 20, 2008, page 3. Applicants continue to disagree.

Again, Brown discloses a system and method for synchronizing files across a number of distributed clients in which those clients synchronize with each other by synchronizing to a common server in a manner whereby the clients may upload or download content to or from the common server. As disclosed (and, incidentally, cited in the Official Action), “the client SA [Synchronization Application] initiates synchronization” Brown, paragraph [0028]. Thus, instead of the entity conducting the upload (client) requesting and receiving an upload schedule from the recipient of the upload (server), similar to amended independent Claim 23, Brown clearly discloses that the entity conducting the upload itself determines the upload schedule. In fact, Brown discloses that its architecture is designed to minimize load on the server, and as a consequence, the architecture offloads “as many processor-intensive operations as possible,” including the synchronization itself, to the client. *Id.* at paragraph [0026].

Similar to Brown, Applicants respectfully submit that neither Son nor Zahariev teach or suggest the aforementioned feature of amended independent Claim 23. Son may disclose streaming content between head-ends or between a local head-end and subscriber equipment at off-peak times. But nowhere does Son teach or suggest that the sender of the stream (sender apparatus) requests to stream content to the recipient of the stream (recipient apparatus), and

receives from that recipient, any direction to stream the content at off-peak hours or any other direction that may reasonably correspond to an upload schedule, similar to amended independent Claim 23.

Newly-cited Zahariev discloses a system and method whereby an email message is delivered to a subscriber's workstation, but if the email message meets subscriber-supplied criteria, an alert is generated and sent to the subscriber's pager. The subscriber may then call in to the system and request separate delivery of the message to an alternate destination, such as a pocket organizer (alternate email address) or fax machine. Even if one could argue that the alert corresponds to an upload request, and that the subscriber's specifying the alternate destination corresponds to an upload schedule (the accuracy of which is expressly not admitted), Zahariev does not teach or suggest that the request (alert) is received by the recipient of the upload (pocket organizer or fax machine), similar to the upload request being received by the recipient of the upload of amended independent Claim 23. And further, Zahariev does not teach or suggest that the sender (Mail Alert Server) of the request (alert) receives direction specifying the alternate destination (upload schedule) from the recipient of the upload (pocket organizer or fax machine), similar to the apparatus receiving the upload schedule from the recipient of the upload of amended independent Claim 23.

2. Determining an Upload Schedule

In further contrast to amended independent Claim 23, none of McDonnell, Brown, Son or Zahariev, taken individually or in any proper combination, teach or suggest receiving, from the recipient of uploaded content, an upload schedule relating to the time and/or manner of uploading that content. The Official Action concedes that neither McDonnell nor Brown, taken individually or in combination, teaches or suggests this feature. Nonetheless, the Official Action alleges that Son teaches the feature, and that it would have been obvious to one skilled in the art to modify the combination of McDonnell and Brown to include the feature of Son, "in order to save costs by determining the non-peak hours when bandwidth is cheaper." Official Action of Jun. 20, 2008, page 3. Applicants respectfully disagree.

Briefly, Son discloses a system and method for content distribution via non-homogeneous

access networks. As disclosed, the system may include a number of head-ends configured to store content for streaming to subscriber equipment, where relative to a particular plurality of subscriber equipment, one of the head-ends is considered local and the others are considered remote. As also disclosed, content may be streamed from a local head-end to subscriber equipment, where the content may be stored at the local head-end or first streamed to the local head-end from a remote head-end. In this regard, as cited in the Official Action, a local head-end may stream content at off-peak times when bandwidth costs are lower. Even if one could argue that the streaming of content at off-peak times constitutes an upload schedule (the accuracy of which is expressly not admitted), nowhere does Son teach or suggest that the recipient of any uploaded content, whether some subscriber equipment, remote head-end or any other recipient, provides the upload schedule, similar to amended independent Claim 23.

Similar to Son, Applicants respectfully submit that neither Brown nor Zahariev teach or suggest the aforementioned feature of amended independent Claim 23. As explained above, Brown clearly discloses that the entity conducting the upload itself (and not the recipient) determines the upload schedule. And as also explained above, nowhere does Zahariev teach or suggest that its recipient (pocket organizer or fax machine) of an email provides an upload schedule relating to the time and/or manner of uploading that content, similar to amended independent Claim 23. In fact, Zahariev does not teach or suggest any apparatus making the determination as to the time and/or manner of uploading content, similar to the recipient apparatus of amended independent Claim 23. Instead, Zahariev clearly discloses that its subscriber makes the determination as to the alternate destination for an email message, communicating that alternate destination to an operator or voice-response system via telephone or two-way pager.

Applicants therefore respectfully submit that none of McDonnell, Brown, Son or Zahariev, taken individually or in any proper combination, teach or suggest sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload, as recited by amended independent Claim 23. As such, Applicants respectfully submit that amended independent Claim 23, and by dependency Claims 24-44, is patentably distinct from McDonnell, Brown, Son and Zahariev,

taken individually or in any proper combination. Applicants also respectfully submit that amended independent Claims 45, 58, 80 and 102, recite subject matter similar to that of amended independent Claim 23, including sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload. As such, Applicants respectfully submit that amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are also patentably distinct from McDonnell, Brown, Son and Zahariev, taken individually or in any proper combination, for at least the reasons given above with respect to amended independent Claim 23.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 1-8, 12, 13, 23-30, 34, 35, 45-48, 51, 52, 58-65, 69, 70, 80-87, 91 and 92 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev is overcome (or rendered moot by virtue of the cancellation of Claims 1-22, 59 and 81).

C. Claims 31, 33, 37-42, 50, 53-57, 66, 68, 72-77, 88, 90 and 94-99 are Patentable

The Official Action rejects Claims 9, 11, 15-20, 31, 33, 37-42, 50, 53-57, 66, 68, 72-77, 88, 90 and 94-99 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Kohno. As explained above, amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son and Zahariev, taken individually or in any proper combination. Applicants respectfully submit that Kohno does not cure the deficiencies of McDonnell, Brown, Son and Zahariev. That is, even considering Kohno, none of McDonnell, Brown, Son, Zahariev or Kohno, taken individually or in any proper combination, teach or suggest the aforementioned sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload, as per amended independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell,

Brown, Son, Zahariev and Kohno, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 9, 11, 15-20, 31, 33, 37-42, 50, 53-57, 66, 68, 72-77, 88, 90 and 94-99 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Kohno is overcome (or rendered moot by virtue of the cancellation of Claims 1-22).

D. Claims 32, 49, 67 and 89 are Patentable

The Official Action rejects Claims 10, 32, 49, 67 and 89 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Squibbs. As explained above, amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son and Zahariev, taken individually or in any proper combination. Applicants respectfully submit that Squibbs does not cure the deficiencies of McDonnell, Brown, Son and Zahariev. That is, even considering Squibbs, none of McDonnell, Brown, Son, Zahariev or Squibbs, taken individually or in any proper combination, teach or suggest the aforementioned sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload, as per amended independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son, Zahariev and Squibbs, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 10, 32, 49, 67 and 89 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Squibbs is overcome (or rendered moot by virtue of the cancellation of Claims 1-22).

E. Claims 36, 71 and 93 are Patentable

The Official Action rejects Claims 14, 36, 71 and 93 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Kobayashi. As

explained above, amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son and Zahariev, taken individually or in any proper combination. Applicants respectfully submit that Kobayashi does not cure the deficiencies of McDonnell, Brown, Son and Zahariev. That is, even considering Kobayashi, none of McDonnell, Brown, Son, Zahariev or Kobayashi, taken individually or in any proper combination, teach or suggest the aforementioned sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload, as per amended independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son, Zahariev and Kobayashi, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 14, 36, 71 and 93 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Kobayashi is overcome (or rendered moot by virtue of the cancellation of Claims 1-22).

F. Claims 43, 44, 78, 79, 100 and 101 are Patentable

The Official Action rejects Claims 21, 22, 43, 44, 78, 79, 100 and 101 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Anderson. As explained above, amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son and Zahariev, taken individually or in any proper combination. Applicants respectfully submit that Anderson does not cure the deficiencies of McDonnell, Brown, Son and Zahariev. That is, even considering Anderson, none of McDonnell, Brown, Son, Zahariev or Anderson, taken individually or in any proper combination, teach or suggest the aforementioned sending an upload request to a recipient to upload content to the recipient, and receiving from that recipient in response to the upload request, a schedule for that upload, as per amended independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit

that amended independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from McDonnell, Brown, Son, Zahariev and Anderson, taken individually or in any proper combination.


For at least the foregoing reasons, Applicants submit that the rejection of Claims 21, 22, 43, 44, 78, 79, 100 and 101 as being unpatentable over McDonnell, in view of Brown, Son and Zahariev, and further in view of Anderson is overcome (or rendered moot by virtue of the cancellation of Claims 1-22).

CONCLUSION

In view of the amendments to the claims and the remarks presented herein, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,


Andrew T. Spence
Registration No. 45,699

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
LEGAL02/31153864v1

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON FEBRUARY 27, 2009.